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09/899,688	07/05/2001	Stephen G. Nelson	744-P-6	3493

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EXAMINER

GRAY, LINDA LAMEY

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 05/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/899,688

Applicant(s)

NELSON, STEPHEN G.8

Examiner

Linda L Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Specification**

1. The use of trademarks has been noted in this application. They should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

**Claim Rejections - 35 USC § 112**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 11-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a substrate having a second surface with dark colored adhesive thereon, does not reasonably provide enablement for a second surface with a dark colored surface where an adhesive is then applied thereto. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.**

The specification indicates that the adhesive is the dark colored material applied to the substrate to make such dark colored on one side. Then the liner is applied over the adhesive. However, claim 14 recites the addition of an adhesive layer over a dark colored surface of the substrate followed by the addition of a liner to the adhesive. Thus, claim 14 essentially adds a second layer (i.e., an adhesive layer) not discussed within the specification.

**Claim Rejections - 35 USC § 103**

4. **Claims 1-7 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shields (US 5,773,110) in view of Andriash (US 5,679,435) and Mimura et al. (US 5,002,825).**

**Claim 1**, Shields teaches a method for producing a one-way see-thru panel (c 1, L 1-9).

The method includes (a) providing opaque light colored substrate 80 having opposite first and second surfaces, (b) applying dark pigmented adhesive 82, (c ) applying release liner 83 over adhesive 82, (d) perforating substrate 80 and liner 83 with a distinct hole pattern, (e) applying

an impermeate barrier 85 over liner 83, and (f) applying an image to the second surface of substrate 80 via printing or painting (c 5, L 9-24).

*Shield does not teach applying the image by inkjet printing.*

Andriash teaches a method for producing see-thru panel including applying an image to a substrate via printing or painting where printing includes inkjet printing (c 5, last para).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields applying the image by inkjet printing because Andriash teaches in the same art that inkjet printing is an alternative to painting where Shields teach painting or printing and it is obvious to replace one method of applying an image with another art recognized alternative method for applying an image.

*Shields modified does not teach an inkjet encapsulating coat under the image.*

Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image. Mimura et al. teach overcoming these shortcomings by providing an inkjet encapsulating coat under an inkjet printed image (c 1).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified an inkjet encapsulating coat under the image because Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image and that such can be overcome by providing an inkjet encapsulating coat under an inkjet printed image.

With respect to the claim limitation of the coating being applied before perforating, it would have been obvious to a person of ordinary skill in the art at the time the invention was

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made to have provided in Shields modified application of the coating before perforating to avoid application of the coating within the perforations which would distort the ability to view of image.

**Claim 2**, Shields does not teach a specific material for panel 80, i.e., that panel 80 is a polymer (plastic) of polyester, vinyl, or polyolefins.

However, display panels of polymers (i.e., plastic) of these materials are conventional because such are slightly flexible and conform well to slightly configured surfaces, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields that panel 80 is a polymer (plastic).

**Claim 3**, in Shields modified the coating includes a resin because Mimura teach such.

**Claim 4**, Shields teaches a method for producing signage for application to a transparent substrate which is a window (c 1, L 1-9). The method includes (a) providing opaque light colored substrate 80 having opposite first and second surfaces, (b) applying pigmented adhesive 82 to the first surface, (c ) applying release liner 83 over adhesive 82, (d) perforating substrate 80 and liner 83 with a distinct hole pattern, (e) laminating an imperforate barrier 85 over liner 83, and (f) applying an image to the second surface of substrate 80 via printing or painting (c 5, L 9-24). Shields teaches removing barrier 85 and liner 83 to expose adhesive 8 and contacting adhesive 82 to the transparent substrate; however, it is noted that these claimed steps are intended use limitations of the article made by the claimed method only. Such are not considered part of the claimed method upon which patentability is based.

*Shield does not teach applying the image by inkjet printing.*

In view of Andriash, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields applying the image by inkjet printing because Andriash teaches in the same art that inkjet printing is an alternative to

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painting where Shields teach painting or printing and it is obvious to replace one method of applying an image with another art recognized alternative method for applying an image.

*Shields modified does not teach an inkjet encapsulating coat under the image.*

In view of Mimura et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified an inkjet encapsulating coat under the image because Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image and that such can be overcome by providing an inkjet encapsulating coat under an inkjet printed image.

With respect to the claim limitation of the coating being applied before perforating, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified application of the coating before perforating to avoid application of the coating within the perforations which would distort the ability to view of image.

*Shields does not teach a specific material for panel 80, i.e., that panel 80 is a polymer (plastic).*

However, display panels of polymers (i.e., plastic) are conventional because such are slightly flexible and conform well to slightly configured surfaces, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields that panel 80 is a polymer (plastic).

***Claims 5-7, Shields modified does not teach inks that are dye based, pigmented, or solvent based (claim 5) and does not teach piezo ink applicators or thermal ink applicators (claims 6-7).***

However, such dyes and applicators are conventional in the art, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified these inks and applicators because it is obvious to replace one type of ink and applicator with other art recognized alternative inks and applicators used for the same purpose.

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**Claim 11**, Shields teaches a method for producing printable signage for application to a transparent substrate which is a window (c 1, L 1-9). The method includes (a) providing opaque light colored substrate 80 having opposite first and second surfaces with pigmented adhesive 82 (i.e., dark) on one of the surfaces and (b) perforating substrate to provide see through visibility when viewed from the adhesive side surface (c 5, L 9-24). Shields also teaches applying an image to the other surface of substrate 80 via printing or painting.

*Shield does not teach applying the image by inkjet printing over an inkjet encapsulating coat.*

In view of Andriash and Mimura et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields applying the image by inkjet printing because Andriash teaches in the same art that inkjet printing is an alternative to painting where Shields teach painting or printing and it is obvious to replace one method of applying an image with another art recognized alternative method for applying an image. Also, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields modified an inkjet encapsulating coat under the image because Mimura et al. teach that printing with inkjet printers often includes a long drying time, a non-smooth surface, poor transcription, and blotting leading to an unclear image and that such can be overcome by providing an inkjet encapsulating coat under an inkjet printed image.

**Claims 11 and 12**, *Shields does not teach a specific material for panel 80, i.e., that panel 80 is a polymer (plastic) of polyester, vinyl, or polyolefins.*

However, display panels of polymers (i.e., plastic) of these materials are conventional because such are slightly flexible and conform well to slightly configured surfaces, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Shields that panel 80 is a polymer (plastic).

**Claim 13**, in Shields modified the coating includes a resin because Mimura et al. teach such. **Claim 14**, Shields teaches applying adhesive 84 and liner 85 on the adhesive side surface. **Claim 15**, as shown above, Shields modified teaches applying an image to the other surface of panel 80.

**Response to Arguments**

5. Applicant's comments filed 5-12-03 have been fully considered.

Applicant's comments with respect to trademarks in the specification is noted.

With respect to the rejection under 35 U.S.C. 112, the specification indicates applying a dark colored adhesive to one side of a substrate to make that side dark in color. Note in claim 11, step (a), there is a substrate having a dark colored surface where the specification indicates that the dark colored surface is provided by the adhesive. Thus, claim 11, step (a), provides a plastic substrate with a dark colored adhesive on one side. Then, claim 14 recites the addition of an adhesive layer over a dark colored surface. Thus, claim 14 adds a second adhesive layer because claim 1 already includes the adhesive layer when reciting that one surface of the substrate is dark because the dark surface is provided by the adhesive per the specification.

Applicant indicates the barrier layer is important because it provides protection during the application of the image against bleed through of inks to the opposite surface. In response, it is noted that the claims do not require the barrier layer to be applied before printing. In any event, Shields indicates in column 5, lines 9-29, that printing occurs after barrier 85 is applied to the assembly including layers 80, 82, and 83.

Applicants indicate that Shields does not teach placing a barrier layer over a release liner to prevent bleeding. In response, Shields teaches applying release liner 83 over adhesive 82 to form an assembly including layers 80, 82, and 83. Then, barrier 85 over the assembly including adhesive 82 (c 5, L 9-24). Thus, Shields does teach placing a barrier layer over a release liner. With respect to the prevention of bleeding discussed by Applicant in the response with respect to the barrier, since barrier 85 of Shields is applied after printing, it is submitted that barrier 85 will prevent bleeding of the print to the other side of panel 80 when printing occurs on the surface of panel 80.

Applicant indicates that Shields teaches hand-painting on the surface of panel 80 and that such teaches away from a preprinted panel. In response, Shields actually teaches painting or printing of panel 80 (c 5, L 25-30); thus, Shields does not teach away from a preprinted panel.

Applicant indicates that since Shields teaches painting or printing and since Andriash deals with a retro-reflective substrate, the combination is not proper. In response, it is granted that Andriash is directed to a retro-reflective substrate; however, this is not seen as negating the general teaching of Andriash of the equivalence of providing an image to a display panel



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either by inkjet printing or painting (c 5, last para) where Shields provides an image to a display panel by printing or painting.

Applicant indicates that the modification of Shields would result in Shields being modified to include retro-reflective surfaces. In response, the combination of Shields with Andriash does not indicate modifying panel 80 of Shields with the retro-reflective sheet material of Andriash.

Applicant indicates that Mimura et al. recognize that a problem exists when applying ink to a porous film and that using a film with a specific pore diameter and undulation index, a better drying speed and clearness with result. However, in response, what Mimura et al. actually teach is that when ink printing on plastic surfaces (Shield modified teaches such a panel 80) (c 1, L 11-17 and 40-47), ink is not absorbed well. Thus, the porous coating (i.e., in encapsulating layer) is provided.

Applicant indicates that the cited references do not teach the inks of claims 5-7. In response, the prior art rejection does not rely on the applied references to teach the inks of claims 5-7 but indicates that such inks are conventional in the art.

**Conclusion**

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**7.** Any inquiry concerning this or earlier communications should be directed Linda L. Gray at 703-308-1093, 6:30am-4:00pm, M-F. The examiner's supervisor, Richard Crispino, can be reached on 703-308-3853. Any general inquiries should be directed to the receptionist at 703-308-0661. The fax numbers are 703-305-7718 (before final) and 703-872-9311 (after final).

llg  
May 27, 2003

*Linda L. Gray*  
LINDA GRAY  
PRIMARY EXAMINER